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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,629	02/23/2004	Joseph P. Errico	F-273	8400
530 7590 04/03/2008 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			EXAMINER WOODALL, NICHOLAS W	
			ART UNIT 3733	PAPER NUMBER
			MAIL DATE 04/03/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/784,629

**Applicant(s)**

ERRICO ET AL.

**Examiner**

Nicholas Woodall

**Art Unit**

3733

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 17-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 December 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is in response to applicant's amendment received on 12/26/2007.

#### ***Allowable Subject Matter***

2. The indicated allowability of claims 11, 12, and 14 is withdrawn in view of the newly discovered reference(s) to Davidson and Myers. Rejections based on the newly cited reference(s) follow.

#### ***Drawings***

3. The drawings were received on 12/26/2007. These drawings are acceptable.

#### ***Claim Rejections - 35 USC § 103***

4. Claims 1-10, 13, 14, and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keller (U.S. Patent 4,997,432) in view of Davidson (U.S. Patent 4,303,268).

Regarding claim 1, Keller discloses a device comprising an extension having a longitudinal axis, at least two prongs connected to a fulcrum at a distal end of the extension and a sleeve collinear with the longitudinal axis of the extension and surrounds at least a portion of the distal end of the extension including the fulcrum and at least portion of the two prongs. Each prong includes a prong extension that defines a contractable and expandable holding enclosure. The sleeve includes a bore that extends along the longitudinal axis of the extension, wherein the bore defines a cross-section having a width that is greater than a depth. Regarding claim 2, Keller discloses a device wherein the device is capable of manipulating a preparation device by at least one of holding, inserting, repositioning, removing, impacting, and extracting. Regarding

claim 3, Keller discloses a device further comprising a handle having a distal end coupled to a proximal end of the extension. Regarding claim 4, Keller discloses a device further comprising a flange that facilitates the rotation of the sleeve. Regarding claim 5, Keller discloses a device wherein the holding enclosure is cylindrical. Regarding claim 6, Keller discloses a device wherein a first of the prongs is spring-loaded with respect to a second of the prongs to bias the holding enclosure to a receptive state in which the first prong and the second prong are separated by a receptive state distance that does not allow a desired engagement diameter of the preparation device to pass between a distal end of the first prong and a distal end of the second prong without altering a portion of at least one of the prongs, wherein a manual pushing of the preparation device in a proximal direction along the extension longitudinal axis between the distal end of the first prong and the distal end of the second prong brings the holding enclosure to an expanded state wherein the distal ends of the prongs are separated by an expanded state distance that allow the desired engagement diameter of the preparation device to completely pass between the prongs, wherein rotation of the sleeve about the extension longitudinal axis brings an inner surface of the sleeve to bear on at least one of the prongs to move the holding enclosure to a contracted state in which the holding enclosure cannot be brought to the expanded state. The examiner believes that the sleeve of the device is capable of being rotated while being longitudinally displaced to perform the functional limitations of claim 6. Regarding claim 7, Keller discloses a device wherein the spring-loading of the prongs relative to one another is effected by at least one of a dimension of at least one of the prongs or a

material strength of at least one of the prongs. Regarding claim 8, Keller discloses a device wherein the distal extension ends are tapered more narrowly toward the holding enclosure to facilitate passage of the preparation device. Regarding claim 9, Keller discloses a device wherein the sleeve is biased toward stopping its rotation at desired positions. Regarding claim 10, Keller discloses a device wherein the biasing is effected by at least one plunger and at least one recess cooperating with the plunger at the desired position. Regarding claim 17, Keller discloses a device wherein the at least one prong extension widens outwardly. Regarding claim 18, Keller discloses a device wherein the at least one prong extension is rigid. Regarding claim 19, Keller discloses a device wherein the at least one prong extension includes a first semicircular extension having a first inwardly facing surface and a second semicircular extension having a second inwardly facing surface that faces the first inwardly facing surface such that the first and second inwardly facing surfaces form the holding enclosure. Regarding claim 20, Keller discloses a device wherein the rotation of the sleeve contracts and expands the first and second inwardly facing surfaces relative to each other. Regarding the statements of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Keller, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the

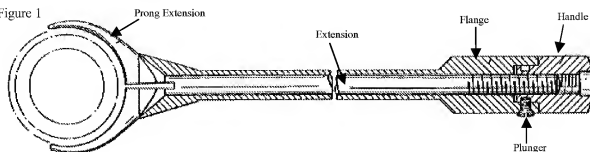
manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987). Keller fails to disclose the bore of the sleeve further defining a cross-section on a plane perpendicular to the longitudinal axis of the extension, wherein the cross-section has a width greater than a depth. Keller discloses a device comprising a sleeve including a bore with a circular cross-section having a tapered portion for contracting the prongs of the device. Davidson teaches a device comprising a sleeve including a bore having a cross-section perpendicular to the longitudinal axis of the extension, wherein the cross-section has a width that is greater than a depth for contracting the prongs of the device. Because both Keller and Davidson teach as device comprising a bore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute one bore for the other in order to achieve the predictable result of contracting the prongs of the device.

Regarding claim 13, the combination of Keller and Davidson disclose a device wherein aligning outwardly facing surfaces of the at least two prongs longitudinally along the sleeve bore width allows the prongs to expand fully without interfering with an inner surface of the sleeve bore and wherein aligning the outwardly facing surfaces of the at least two prongs longitudinally along the sleeve bore depth causes interference between at least one of the outwardly facing surfaces of at least one of the prongs and at least one of the inner surfaces of the sleeve bore. Regarding claim 14, the combination of Keller and Davidson disclose a device wherein at least one of the sleeve bores includes at least one corner having a corner curvature shaped as a radius of the

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sleeve bore and wherein at least one outwardly facing surface of at least one of the prongs is curved such that the curved prongs and the corner curvature are capable of facilitating the rotation of the sleeve.

Figure 1



5. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keller (U.S. Patent 4,997,432) in view of Davidson (U.S. Patent 4,303,268) further in view of Myers (U.S. Patent 4,317,387).

Regarding claims 11 and 12, the combination of Keller and Davidson disclose the invention as claimed except for the plunger being biased from an inner sleeve surface inwardly, wherein the plunger includes a spring. The combination of Keller and Davidson disclose a device comprising a positioning mechanism comprising at least one plunger located within a portion of a sleeve wall bore and at least one sleeve wall bore penetrating through the wall of the sleeve in order to position the sleeve relative to the extension. Myers teaches a device comprising a sleeve, an extension, and a positioning mechanism. The positioning mechanism includes at least one plunger located within a portion of a sleeve wall bore, at least one sleeve wall bore penetrating through the sleeve wall, and at least one recess located on an outer surface of the extension, wherein the plunger further includes a spring capable of biasing the plunger

inwardly from an inner sleeve surface such that the at least one plunger aligns with and is partially contained within the at least one recess in order to position the sleeve relative to the extension. Because both the combination of Keller and Davidson and Myers teach devices comprising positioning mechanisms, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute one positioning mechanism for the other in order to achieve the predictable results of positioning the sleeve relative to the extension.

Further regarding claim 11, the combination of Keller, Davidson, and Myers disclose a device wherein the sleeve is capable of being rotated about the longitudinal axis of the extension such that the at least one plunger aligns with and is at least partially contained within the at least one recess.

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 1-14 and 17-20 have been considered but are moot in view of the new ground(s) of rejection. The examiner has presented new grounds of rejection as discussed above that were not necessitated by amendment making this office action non-final.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for cited references the examiner felt were relevant to the application.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Woodall whose telephone number is (571)272-5204. The examiner can normally be reached on Monday to Friday 8:00 to 5:30 EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nicholas Woodall/  
Examiner, Art Unit 3733

/Eduardo C. Robert/  
Supervisory Patent Examiner, Art Unit 3733